REMARKS

Claims 1-32 are currently pending, although claims 18-25 and 31 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants intend to seek appropriate rejoinder of withdrawn claims pursuant to MPEP 821.04.

The Office Action rejected claims 1-17, 26-30 and 32 under 35 U.S.C. §103 as obvious over U.S. patent 6,123,952 ("Lagrange") in view of PCT patent application publication no. WO 99/31081 ("Clarke"). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of this rejection.

The Office Action has recognized that Lagrange neither teaches nor suggests the required dyes. To attempt to compensate for this fatal deficiency, the Office Action asserted that one skilled in the art would have been motivated to replace Lagrange's dyes with Clarke's dyes because both types of dyes can generally be described as "photochromic organic dyes" --- that is, it would have been obvious to replace one type of photochromic organic dye with another. However, this assertion misses the point, and ignores the express teachings of the applied art.

First, Clarke's dyes are reversible chromatic compounds given the "rapid fading" associated with Clarke's dyes. (See, page 3, 1st paragraph). Clarke seeks such rapid reversibility of his dyes -- it is a necessary part of his "invention." In stark contrast, Lagrange's compositions contain only irreversible photochromic compounds. ***In fact, Lagrange specifically excludes reversible photochromic compounds from his compositions. (See, col. 2, lines 59-62).*** Given these disclosures, one skilled in the art would not have been

motivated to place one of Clarke's reversible dyes into Lagrange's compositions which require the presence of irreversible dyes. To make such a substitution would render Lagrange's compositions unsuitable for their intended purpose. ***Thus, rather than suggest the claimed invention, the applied art actually teaches away from it and precludes it.*** Under such circumstances, Clark and Lagrange cannot form the basis for a rejection under 35 U.S.C. §103. See, MPEP 2143.01 III, V and VI.

Second, Clarke neither teaches nor suggests dissolving the required dye in the oily phase. Rather, Clarke teaches away from such dissolution, stating that his dyes are incorporated into polymeric materials. (See, page 5, 2nd and 3rd paragraphs). Thus, one skilled in the art would not be led to attempt to substitute one of Clarke's reversible dyes for one of Lagrange's irreversible dyes for the additional reason that he/she would not have had proper motivation/knowledge concerning how to make such a substitution. This is particularly true for claim 32 which requires the claimed dye to be dissolved in the oily phase.

Third, Clarke teaches that his dyes are incorporated into polymeric "host materials" which do not in any way, shape or form resemble human keratin materials. (See, pages 5-6). Thus, one skilled in the art would not be led to attempt to substitute one of Clarke's reversible dyes for one of Lagrange's irreversible dyes for the additional reason that he/she would not have had proper motivation/knowledge concerning how to make such a substitution in a cosmetic composition for application onto a keratin material. This is particularly true for claim 31 which requires application onto human substrates, not into such substrates.

In summary, the applied art teaches away from adding one of Clarke's reversible dyes into Lagrange's compositions and, thus, teaches away from the claimed invention.

Furthermore, the applied art would not have provided sufficient information/motivation to one skilled in the art to enable him/her to produce the claimed invention. It is only through use of impermissible hindsight, using the present application as a guide, that the Office Action can cobble together the contradictory teachings of the applied art to assert that the claimed invention would have been obvious. Such an analysis is improper, and the rejection based upon the analysis should be withdrawn.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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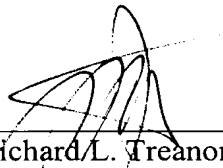

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